

**REMARKS**

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-2, 4-6, 8-9, 11, 13-16, 22, 24 and 26-28 are presently active in this case. The present Amendment amends Claims 1, 8, 13 and 15; and adds new Claims 26-28 without introducing any new matter; and further cancels Claims 21, 23 and 25 without prejudice or disclaimer.

The outstanding Office Action rejected Claims 1, 8, 15, 21 and 23 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claims 1, 8, 15, 21 and 23 under 35 U.S.C. §112, second paragraph, as indefinite. Claims 1-2, 4-6, 8-9, 11, 13-16 and 21-25 were rejected under 35 U.S.C. §103(a) as unpatentable over Ohtsuka (U.S. Patent No. 6,327,049).

In response to the objection to Claims 21, 23 and 25 under 37 C.F.R. §1.75, these claims are herewith cancelled without prejudice or disclaimer. In addition, Claims 1 and 13 are amended to delete the features regarding “the first image information stored in the storage is expanded,” and “in a compressed format,” to present these features in new dependent Claims 26-28 for examination.

In response to the rejection of Claims 1, 8, 15, 21 and 23 under 35 U.S.C. §112, first and second paragraph, Applicants believe that Figure 9A, showing image elements 11, 12 and 13 superposing each other, together with Applicants’ specification from page 27, lines 4-18 and at page 29, lines 13-19 clearly explain that a portion of the image information is “thereby not visible in a superimposed image of the at least two elements.” Therefore, these features clearly find non-limiting support in Applicants’ specification as originally filed, even if such a wording is not literally found in the specification. However, in the spirit of moving the prosecution of the application forward, Claims 1, 8 and 15 are amended to delete these

features, and Claims 21 and 23 is cancelled without prejudice or disclaimer. In view of amended Claims 1, 8, and 15, it is believed that all pending claims are definite and no further rejection on that basis is anticipated.

In response to the rejection of Claims 1, 8, 15, 21 and 23 under 35 U.S.C. §112, second paragraph, as indefinite, the expression “for printing” of Claims 1, 8 and 15 is amended to recite “for printing by a printing device provided at the information processing apparatus.” This feature finds non-limiting support in the specification as originally filed, for example at page 17, lines 7-13, and in Figure 2. In view of amended Claims 1, 8 and 15, it is believed that all pending claims are definite and no further rejection on that basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually acceptable language.

In light of the amendments to independent Claims 1, 8 and 15, Applicants respectfully request reconsideration of this rejection and traverse the rejection under 35 U.S.C. §103(a), as discussed next.

Briefly recapitulating, Claim 1 relates to an image processing apparatus including, *inter alia*: a communication unit configured to communicate with an information processing apparatus, the information processing apparatus configured to operate on image information; a storage configured to store first image information which represents at least one element; and a controller configured to send second image information to the information processing apparatus, wherein the controller is further configured to acquire result information, the result information being a result of an operation executed for the sent second image information on the information processing apparatus, ***the result information includes information indicating an order of at least one element in the second image information*** in a direction perpendicular to a display screen; the controller is further configured to edit the first image

information, the first image information is edited according to the acquired result information; and the *controller is further configured to send the edited first image information to the information processing apparatus for printing by a printing device provided at the information processing apparatus.*

Independent Claims 6, 8, 11, 13 and 15-16 recite similar features in the context of a image processing apparatus (Claim 6), image processing method (Claims 8 and 11), image information distribution method (Claim 13 and 15), and a storage medium including a computer readable program code (Claim 16).

Turning now to the applied reference, Ohtsuka discloses a printing service for processed images, in which data transfer can be reduced and the usage of image data and templates can be limited.<sup>1</sup> Ohtsuka further explains that a user carries out processing ordering from a laboratory 2 and that an *order file* describing image data and the template is provided to the laboratory.<sup>2</sup> Subsequently, in Ohtsuka, an edited image data is then printed out at the laboratory.<sup>3</sup>

However, Ohtsuka fails to teach a controller being further configured to send the edited first image information to the information processing apparatus for printing by a printing device provided at the information processing apparatus. On the contrary, Ohtsuka explicitly explains that “templates used for generating prints are not provided to a user, but *stored in a system of a service provider only*” (emphasis added).<sup>4</sup> Therefore, Ohtsuka clearly teaches away from Claim 1, “[a] reference may be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was

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<sup>1</sup> See Ohtsuka in the Abstract, lines 1-4.

<sup>2</sup> See Ohtsuka in the Abstract, lines 4-10.

<sup>3</sup> See Ohtsuka at column 9, lines 33-39.

<sup>4</sup> See Ohtsuka at column 5, lines 44-47.

taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

It can be further seen from Ohtsuka’s Figures 1-2 that the user, employing his or her terminal 5, merely provides an order file 6 to a laboratory system 2 for ordering an image at the laboratory 2, and that *the laboratory system provides a high resolution image data 4*, where the user is registered.<sup>5</sup>

Ohtsuka clearly fails to teach or suggest a printer device at the user terminal 5, and Ohtsuka explains that the print size and quantity of prints can be calculated at the user terminal 5 by the processing application 31,<sup>6</sup> however, a full-resolution image template is never delivered to Ohtsuka’s user terminal 5.<sup>7</sup>

The outstanding Office Action asserts that “it would have been obvious to ordinary skill in the art to have [a] controller from [a] print laboratory system to send the edited/processed image back to [the] client apparatus for printing.”<sup>8</sup> Applicants respectfully disagree with such a statement, since not only does Ohtsuka fails to teach or suggest all the features and their interrelationships of the claims, but it is also submitted that Ohtsuka teaches away from the claimed invention, as explained above. In this regard, Applicants submit that the outstanding Office Action is clearly using improper hindsight in rejecting the claims. See *In re Lowry*, 32 F.3d 1579, 1583, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) to recite “[t]o establish a prima facie case of obviousness, the burden of establishing the absence of a novel, nonobvious functional relationship rested with the Patent and Trademark Office,” and “[t]he claimed invention involved an organization of information and its interrelationships that the prior invention neither disclosed nor suggested.” See also *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981

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<sup>5</sup> See Ohtsuka at column 6, lines 58-65.

<sup>6</sup> See Ohtsuka at column 8, lines 37-41.

<sup>7</sup> See Ohtsuka at column 9, lines 5-20.

<sup>8</sup> See the outstanding Office Action at page 5, lines 16-19.

(Fed. Cir. 1998) “[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.”

In addition, Ohtsuka fails to teach or suggest that

the controller is further configured to edit the first image information, the first image information is edited according to the acquired result information, so that if at least two elements superimpose each other, a portion of the image information covered by any of the at least two elements is not included by the edited first image information;

of Claim 1. Since in Ohtsuka the final image is printed at the laboratory system, Ohtsuka does not need the above feature of Claim 1 regarding the edited first image information. Ohtsuka merely describes a number of possible image processing method and effects that can be carried out upon printing processing, but fails to specifically teach or suggest “a portion of the image information covered by any of the at least two elements is not included by the edited first image information,” as recited in independent Claim 1.

Independent Claims 6, 8, 11, 13 and 15-16 recite features analogous to the features recited in independent Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejections of Claims 6, 8, 11, 13 and 15-16, and the rejections of the associated dependent claims, are also believed to be overcome in view of the arguments regarding independent Claim 1

Therefore, the applied reference fails to teach or suggest every feature recited in Applicants’ claims, so that Claims 1-2, 4-6, 8-9, 11, 13-16, 22, 24 and 26-28 are believed to be patentably distinct over the applied references. Accordingly, Applicants respectfully traverse, and request reconsideration of, the rejection based on Ohtsuka.<sup>9</sup>

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in

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<sup>9</sup> See MPEP 2131: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” (Citations omitted) (emphasis added). See also MPEP 2143.03: “All words in a claim must be considered in judging the patentability of that claim against the prior art.”

condition for formal Allowance. A Notice of Allowance for Claims 1-2, 4-6, 8-9, 11, 13-16, 22, 24 and 26-28 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

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